



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,534	08/03/2001	Richard B. Himmelstein	4159-4003US2	6981
7590		08/11/2004	EXAMINER	
Walter G. Hanchuk		BACKER, FIRMIN		
Morgan & Finnegan, LLP		ART UNIT		
345 Park Avenue		PAPER NUMBER		
New York, NY 10154		3621		

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,534

Applicant(s)

HIMMELSTEIN, RICHARD B.

Examiner

Firmin Backer

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 03 March 2004.

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-20,24,25 and 28-54 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-20,24,25 and 28-54 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) ☐ Interview Summary (PTO-413) Paper No(s). _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 3rd, 2004 has been entered.

Response to Amendment

2. A preliminary amendment has been filed on March 3rd, in which claim 1, 14, 15, 17 and 31 have been amended. Claims 33-54 have been added and claims 26, 27 were previously canceled. Claims 1-25 and 28-54 are now pending.

Response to Arguments

3. Applicant's arguments with respect to claims 1-25 and 28-54 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3621

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-20, 24, 25 and 28-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satow et al (U.S. PG Pub 2003/0050888 A1) in view of Nieboer et al (U.S. Patent No. 6,418,419).

6. As per claims 1, 14, 15, 17 and 31, Satow et al teaches a system for implementing barter between a plurality of parties each having one or more security available for barter comprising means for creating a barter order (*see paragraph 0053*) including means for designating a selected quantity of first security (*first trade order*) to be bartered (*see paragraph 000012, 0013*), mean for designate a selected quantity or a second security (*second trade order*) to be purchased in a transaction including the sale of the first security, means for posting (*displaying order*) barter orders (*order to buy and sell*) via the internet (*public network*) at least one matching barter order (*see figs 1, 3 paragraph 0021, 0023, 0024*), and means for designating a financial value associated with the transaction (*paragraph 0032, 0033, 0042, 0048*) Satow further teach means for receiving barter order from a direct barterer and from an intermediary into the database (*see paragraphs* . Satow et al fails to teach means for designating a second security to be purchased in a transaction including the sale of the first security, the second security different that the first means for designating a financial value associated with the transaction. However, Nieboer et al teach means for designating a second class of items to be purchased in a transaction including the sale of the first security, the second security different that the first means for designating a financial value associated with the transaction (*see fig 5, column 6 lines 24-40, 8 lines 28-52, 15*

Art Unit: 3621

lines 52-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Satow et al's inventive concept to include Nieboer et al's concept of means for designating a second class of items to be purchased in a transaction including the sale of the first security, the second security different that the first means for designating a financial value associated with the transaction because this would have improved the efficiency of the barter transact conditional buy and sell orders for security of commerce in real time thereby reduce transaction cost to the traders.

7. As per claim 2, Satow et al teaches a system wherein the means designating a financial value comprises means for designating a sale price of the first security and the purchase price for second security (*paragraph 0048*).

8. As per claim 3, Satow et al teaches a system wherein the barter value means for designating a financial value included means for designating the sale of the first security and the purchase of the second security each respective market value (*see paragraph 0048*).

9. As per claim 4, Satow et al teaches a system wherein the means designating a financial value further include means for designating a net financial value for the transaction (*see paragraph 0048*).

10. As per claim 5, Satow et al teaches a system wherein the means for displaying displays matching barter orders based on the designated date range (*see fig 3*).

11. As per claim 6, Satow et al teaches a system wherein the means for creating a bartering order further includes means for designating applicable dividend reinvestment preferences for the first class and second security and the means for displaying displays barter orders having dividend reinvestment preferences (*see fig 3, paragraph 0042, 0048*).

12. As per claim 7, Satow et al teaches a system wherein the means for designating a financial value comprises designating the financial value realized from executing the transaction with the selected matching barter order (*see paragraphs 0042, 0048*).

13. As per claim 8, Satow et al teaches a system wherein the means for creating a new barter order further includes means for accessing records related to current market value of the first security and the second security (*see fig 3*).

14. As per claim 9, Satow et al teaches a system wherein the means for displaying displays a plurality matching barter orders arranged by the net financial value of the transaction (*see fig 3, paragraph 0042, 0048*).

15. As per claim 10, Satow et al teaches a system wherein the first and second securities are selected from a group of comprising stock, stock options, specified rights in stocks, notes, certificate of deposit, bonds and barter dollars (*see 4, paragraph 0021*).

16. As per claim 11, Satow et al teaches a system wherein the item classes are limited to stock (*see fig 4, paragraph 0021*).

17. As per claim 12, Satow et al teaches a system further comprising means for tracking transactions for reporting taxable events (*see paragraph 0023*).

18. As per claim 13, Satow et al teaches a system further comprises means for concluding a transaction based on the new barterer's order and a selected matching barter order, identifying residual amounts reflective of value disparity between the new and matching orders of the transaction, and designating a recipient of the residual amounts (*see paragraph 0042*).

19. As per claim 16, Nieboer et al teaches a method wherein creating a new barter order includes designating a date range for transferring title of the selected quantity of the first class of items to be bartered whereby may elect to defer the transfer of title to the first security to a time after the transaction or elect to transfer title along with the completion of the transaction (*see column 13 table*).

20. As per claim 18, Nieboer et al teaches a system wherein the financial value included a sale of the first security and a purchase value of the second security and further including means for calculating and displaying a value ratio based on the sale value of the first security and the purchase value of the second security (*see column 3 lines 49-64*).

Art Unit: 3621

21. As per claim 19, Nieboer et al teaches a system wherein the value ratio is calculated based upon a combination of the ratios x/y and a/b where: a = the barter value of the first class of items to be bartered, b = a market price of the first security to be bartered, x = the barter value of the second class of items to be acquired and y = a market price of the second security to be acquired (*see column 3 lines 49-64*).

22. As per claim 20, Nieboer et al teaches a system further comprising means for selecting a desired formula from among a plurality of formulas to calculate the value ratio (*see column 3 lines 49-64*)

23. As per claim 24, Nieboer et al teaches a system where the means for creating a barter order further includes means for designating a quantity and a barter value of the second class of items such that fractional values of the quantities of the first security and the second (*see column 3 lines 49-64*).

24. As per claim 25, Nieboer et al teaches a system where the means for creating a barter order further includes means for designating a fractional values of the quantities of the first security and the second security (*see column 3 lines 49-64*).

25. As per claim 28 and 32, Satow et al teaches a system wherein the financial value comprises one of the group including a sale price of the first security and a purchase price of the second security, a net price for the transaction including the sale of the first security and the

Art Unit: 3621

purchase of the second security an indication to sell the first security at the market price and purchase the second security at market price and the financial value realized from executing the transaction with a selected matching barter order (*see paragraphs 0042, 0048*).

26. As per claim 29, Satow et al teaches a system wherein the matching barter order included the first security to be purchase and the second security to be sold (*see paragraphs 0048*).

27. As per claim 30, Satow et al teaches a system wherein the matching barter order further include intermediate barter orders including at least on of the first security and second security (*see paragraph 0048*).

28. As per claims 33-54, they disclose variation of the inventive concept disclosed in claims 1-20 and 28-32. Therefore, they are rejected under the same rationale

Allowable Subject Matter

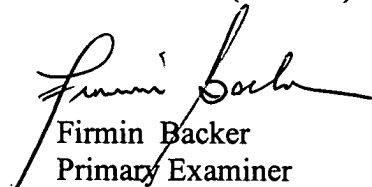
29. Claims 21-23 are objected to as being dependent upon a rejected base claim, but would be allowable if the provisional double patenting rejection is overcome and if the claims are rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Firmin Backer
Primary Examiner
Art Unit 3621

August 4, 2004